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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------------|------------------|
| 10/670,514  | 09/26/2003  | Herbert C. Boehm     | 20002.0339                 | 4064             |
| 23517   | 7590        | 05/18/2005           |                            |                  |
| SWIDLER BERLIN LLP<br>3000 K STREET, NW<br>BOX IP<br>WASHINGTON, DC 20007 |             |                      | EXAMINER<br>GORDEN, RAEANN |                  |
|   |             |                      | ART UNIT<br>3711           | PAPER NUMBER     |

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

**Office Action Summary**

Application No.

10/670,514

Applicant(s)

BOEHM ET AL.

Examiner

Raeann Gorden

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-19, 21-25, 27-38, 40-45, 47-58 and 60 is/are pending in the application.
- 4a) Of the above claim(s) 5, 20, 26, 39, 46 and 59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-15, 17-19, 21-25, 27-36, 38, 40-45, 47-56, 58 and 60 is/are rejected.
- 7) ☒ Claim(s) 16, 37 and 57 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br/>         Paper No(s)/Mail Date <u>9-26-03</u>.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)<br/>         Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
|---|---|

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Groups 1a and 2b in the reply filed on 2-28-05 is acknowledged. The traversal is on the ground(s) that there is no undue burden on the Examiner to search all the claims. This is not found persuasive because the claimed features cannot coexist. For example, the golf ball cannot have a MOI less than 0.450 and greater than 0.460 simultaneously.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 17, 29, 38, 49, and 58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 8, 29, and 49 refer to the core and first and second mantle layers. However, according to the base claims the mantle layers are included as part of the core. Claims 17, 38, and 58, no antecedent basis for pentachlorothiophenol.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-12, 14, 15, 18, 19, 21-25, 27-33, 35, 36, 40-45, 47-53, 55, 56, and 60 are rejected under 35 U.S.C. 102(e) as being anticipated by Molitor (6,299,550). Regarding claims 1, 22, 23, and 41, Molitor discloses a golf ball comprising a liquid core, two or three intermediate layers and a cover (fig 50). The intermediate layers may be made from ionomeric or non-ionomeric materials (col. 22). The outer cover layer may be made from thermoplastic or thermoset polyurethane (col. 24). Regarding claims 2-4, 24, 25, 44, and 45, the liquid core may include oils (col. 12). Regarding claims 6-11, 18, 19, 27-32, 42, 43, 47-52, the intermediate layers may be made from ionomeric or non-ionomeric materials (col. 22). Examples include partially neutralized ethylene copolymers and terpolymers (cols. 23-24). The outer cover layer may be made from thermoplastic or thermoset polyurethane (col. 24). Regarding claims 12, 33, and 53, the golf ball has a diameter of at least 1.68 inches (col. 21). Regarding claims 14, 15, 35, 36, 55, 56, the core has a diameter up to 1.62 inches and the outer cover has a thickness from 0.02 to 0.20 inch (col. 13, 50). Regarding claims 21, 40, and 60, the golf ball has a MOI of 0.240 (col. 21).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 34, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molitor (6,299,550). Molitor discloses the intermediate layer thickness values from 0.02 to 0.20 inch, which is outside the applicant's claimed range. However, one of ordinary skill in the art would vary the thickness of the layers for enhanced durability.

***Allowable Subject Matter***

Claims 16, 37, and 57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

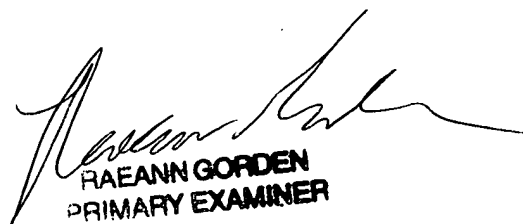
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 571-272-4409. The examiner can normally be reached on M-F 9-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rg  
May 16, 2005



RAEANN GORDEN  
PRIMARY EXAMINER